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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/644,382 | 08/23/2000 | Jason Goldberg | 4905.P002 | 1511 |

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EXAMINER

BOCCIO, VINCENT F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2616

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/644,382 | Applicant(s) GOLDBERG ET AL. | |
| | Examiner Vincent F. Boccio | Art Unit 2616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,13-18,25,26,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,13-18,25,26,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

1. Applicant's election without traverse of Group II in the reply filed 10/20/04 is acknowledged.
Claims 1-6, 9-12, 19-24, 27-29 and 32-39 have been cancelled.
Claims 7-8, 13-18, 25-26 and 31 remain.

Response to Arguments

1. Applicant's arguments filed 9/24/04 have been fully considered but they are not persuasive.
{A} In re page 10, applicant traverses the official notice, "Applicant's believe that the examiner has failed to read the language of the claims as a whole."

In response the examiner cites, "Ludtke, US 6,202,210, FD August 21, 1998", col. 7, "periodically sends the history file (e.g., once a day) to the central data collection server ... via a modem", thereby providing an automatic data collection and retrieval capability, such as viewing history, purchase habits, home shopping, virtually any other interaction between the user and the home AV network to be analyzed by any interested party, thereby establishing a basis for habits affect future business practices of the parties, sell and use the data for example , to make money, etc..... ,
col. 7, lines 40- etc.....

Based on the combination the examiner renders it obvious to upload system (associate with the system & user) data, periodically from the user's device, which is a DVD system, as would have been obvious to those skilled in the art.

{B} In re page 11, applicant states, "applicant's have reviewed the cited section and ... have been unable to discern any part in Abgrall that teaches a local directory structure where each directory is associated with a device."

Based on the cited passages, such as,

Abgrall teaches at col. 9, line 44-, wherein a profile manager obtains user and system profiles of the computer system 100, such as hardware, software installed at the computer, wherein this information is provided to server 22, which is used to match preferences and targets content data to users based on the system data (hardware/software).

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Based on Abgrall, user's have their profile stored, based on user preferences, hardware and software, wherein the server, having the directory structure, met by the database, matches the user indicated with database, based on forwards results at predetermined intervals or at the user's request, it is clear, based on col. 9, line 40-, that the local directory structure is the database associated with server 22, therefore, a directory is maintained at a server, being hardware profiles, user preferences, which was retrieved from the device, upon matching information with the database and to provide the results to the user in view thereof.

Therefore, the arguments are not deemed persuasive.

{C} In re page 11-12, "the examiner has engaged in high-sight piece-meal reconstruction",

"Applicants have been unable to discern any part of Nishio that teaches a local directory structure, wherein each directory is associated with a device";

"the Examiner has not provided any motivation to combine".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Nishio, has not been combined for the stated purpose of applicant, therefore, arguments are not persuasive, Nishio has been combined to render obvious elements of a processor, commands to retrieve, not specifically mentioned in the other used references.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.

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Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

All 103 rejections are provided with one of common knowledge, stated or suggested by the references applied.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 7 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493).

Since the claims 7 and 25 have not been amended the examiner incorporated by reference the last action against the claims.

3. Claims 8, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493) in view of Jefferson et al. (US 5,712,994).

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Since the claims have not been amended the examiner incorporated by reference the last action against the claims.

4. Claims 13-17, 30-31 (new) are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493) in view of Abgrall (US 6,401,202) and Nishio et al. (US 5,557,317) and Ludtke (US 6,202,210).

Since claims 13-17, have not been amended the examiner incorporated by reference the last action against the claims.

Regarding claim 31, based on the combination as applied fails to address, wherein the server receives purchase data collected from user's of the device.

Ludtke teaches col. 7-8 etc....., periodically sending a history file once a day, collect a variety of useful data, viewing and purchasing habits, to determine habits which affect future business practices, as taught by Ludtke.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by incorporating collecting purchase data, collected from user's of the device, as taught by Ludtke.

Claim 30, based on the combination, is met by, Butler, page 1, col. 2, discloses,

- "broadcast source 12 will support only uni-directional";
- "broadcast source 12 alternatively support bi-directional communications (therefore, two channels);

and further discloses a modem 138, associated with an internet back channel", being a bidirectional source, therefore, meeting the limitation of (two channels),

"wherein the device and server communicate on multiple channels to exchange different types of data", wherein ancillary content may be in the broadcast source, using a backchannel thru the modem, thereby meeting the claimed limitation of different channels, further even the modem also represents different channels, one forward channels to receive data from the server and one back to send data to the server.

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5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Butler et al. (US 2002/0007493), Abgrall (US 6,401,202) and Nishio et al. (US 5,557,317) and further in view of Jefferson et al. (US 5,712,994).

Since the claim have not been amended the examiner incorporated by reference the last action against the claims.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Fax Information


Any response to this action should be faxed to:

(703) 872-9306, (for communication intended for entry)

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
5/15/05


VINCENT BOCCIO
PRIMARY EXAMINER